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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,598	11/24/2003	Robert Reynolds	BSC-188C1	5007
22852	7590	03/27/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WERNER, JONATHAN S	
			ART UNIT	PAPER NUMBER
			3732	
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			03/27/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,598

Applicant(s)

REYNOLDS ET AL.

Examiner

JONATHAN WERNER

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3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-57 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 38-57 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

This action is in response to Applicant's amendment received 9/21/07.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1) Claims 38-40, 42, 44, 47-52, and 54-55 are rejected under 35 U.S.C. 102(e) as being anticipated by White et al (USPN 6,872,211). White et al disclose a medical device (10), comprising: a sheath (17) comprising a proximal end and a distal end; a handle (11) at the proximal end of the sheath (17); a basket (15) having a collapsed position when the basket is within the sheath (see Fig. 4A) and collapsed and an expanded position when the basket (15) is positioned beyond the distal end of the sheath (17) and expanded (see Fig. 2), the basket (15) comprising a plurality of wires (21) (see col. 10, lines 57-59), a proximal end (22), and a distal end (24), the distal end (24) of the basket (15) failing when a predetermined force applied to the basket (15) is less than a force required to cause one of the plurality of wires (21) or the proximal end of the basket (15) to fail (see col. 12, lines 64-67). Examiner further notes that Applicant has claimed statements of intended use and other functional statements, i.e. how the

ends of the plurality of wire release from each other when a predetermined force is applied to the basket. Such functional limitations fail to further structurally distinguish the present invention from the prior art. Moreover, the distal ends of the plurality of wires (21) are shown joined together, for example in Figures 10A-10C, via basket portions (28), such that they are capable of being released from each other when a certain force is applied to the basket since the connecting joint member (27) has an opening at its proximal end that allows for the basket portions (28) to become detached from from the wires (21) (see especially Figures 7A and 8B which show a front view of said joint, whereby the crimped section is not entirely closed). As to claim 39, the cross-section of at least one of the plurality of wires (where "24" is shown) is D-shaped (see Fig. 19A). As to claim 40, the cross-section of at least one of the plurality of wires (21) is V-shaped (see Fig. 19A). Regarding claim 42 each of the plurality of wires comprises a proximal end and a distal end, the distal ends of the plurality of wires are joined (at "32" as shown in Fig. 22A). To claim 44, the basket in the expanded position is wider at the distal end than at the proximal end (see Fig. 22A). As to claim 47, the basket distal end comprises a tip member (25) (see alternate embodiment shown in Fig. 17). Regarding claim 48, the tip member (25) is tubular and comprises a proximal end, a distal end (23), and a lumen extending therethrough, the lumen of the tubular tip member is adapted to receive an end of the basket wires therein (see col. 7, lines 22-24). To claims 49 ad 50, Fig. 17 shows the tip member is sealed at the distal end and the distal end of the tip member has a spherico-conical shape. With respect to claims 51-52 and 54, the basket distal end comprises a solder joint, weld joint or an adhesive

joint. Finally to claim 55, at least one wire comprises stainless steel (see col. 10, lines 57-59).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 43, 45-46, 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. White substantially discloses the claimed invention except for the plurality of wires each comprising four bends. It would have been obvious to one having ordinary skill in the art to have the wires comprise any number of bends, since applicant has not disclose that four bends solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any number of bends in each wire.

Regarding claims 45-46, White et al substantially disclose the claimed invention except for the radial stiffness of at least one wire being greater than 0.7 g/mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use wires with a stiffness value that would render the wires capable of retrieving stones including a value greater than 0.7g/mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

To claim 53, White et al discloses the basket distal end may comprise a variety of different joints, however, White et al does not disclose the basket distal end comprises an over-molding joint. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an over-molding joint since the examiner takes Official Notice of the equivalence of an over-molding joint and an adhesive joint for their use in the basket retrieval art and the selection of any of these known equivalents to fix the legs or wires of the basket together would be within the level of ordinary skill in the art.

Further to claim 56, White et al discloses at least one wire may comprise a stainless steel, however, they do not teach at least one wire may comprise a nickel titanium alloy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a nickel titanium alloy wire, since it has been held to be within the general skill of a worker in the art to select a known material on the basis

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of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

2) Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al in view of Bates (USPN 5,944,728). White et al substantially disclose the claimed invention except for the distal end of at least one wire being scored. Bates teaches the "inner surface of the legs can comprise a surface that is rougher than the outer surface, and this roughness can comprise, for example, a serrated surface, a toothed surface of an etched surface" (see col. 2, lines 35-38). An etched surface is considered to be scored. It would have been obvious to one having ordinary skill in the art at the time the invention was made to score at least one wire or leg of the basket as taught by Bates in order to enhance stone capture and retention.

3) Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al in view of Bates (USPN 6,800,080). White substantially discloses the claimed invention except for the handle being detachable. Bates teaches a similar expandable device with removable handles (see col. 7, lines 1-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the handles detachable as taught by Bates in order to make the device more versatile for the user.

Response to Arguments

Applicant's arguments with respect to claim 38 have been considered but are moot in view of the new ground(s) of rejection. Applicant has amended claim 38 to

recite that the distal ends of the plurality of wires are joined and which are released from each other when a force is applied to the basket, thus causing the wires or the basket to fail. As noted in the rejection above, Examiner points out that such a statement constitutes a limitation directed toward the intended use of the device without structurally distinguishing it from that of the prior art, which, as detailed above, is capable of performing as claimed. Examiner reminds Applicant that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN WERNER whose telephone number is (571)272-2767. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3/18/08

/Jonathan Werner/
Examiner, Art Unit 3732

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732